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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,558	06/13/2001	Tomoyuki Asano	09792909-5109	7084
26263 7590 05/29/2008 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080				
EXAMINER				
NGUYEN, NGA B				
ART UNIT		PAPER NUMBER		
3692				
MAIL DATE		DELIVERY MODE		
05/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/880,558

Applicant(s)

ASANO, TOMOYUKI

Examiner

Nga B. Nguyen

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18 and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C2)
Paper No(s)/Mail Date 2/19/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 19, 2008 has been entered.
2. Claims 17, 18, and 20-27 are pending in this application.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on February 19, 2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments/Amendment

4. Applicant's arguments with respect to claims 17, 18, and 20-27 have been considered and moot in view of new ground of rejection.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 17, 18, and 20-27 are provisionally rejected on the ground of nonstatutory double patenting over claims 17, 18, 20-22, 24-26 and 28-31 of copending Application No. 09/880,173. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: A method for collecting a fee for a service of a service provider comprising the steps of: receiving a request from said service provider to collect the fee from a user...; receiving an IC card from the user, said IC card including service request data and digital signature data...; determining whether said service request data and said digital signature data are valid...; said service request data recorded on said IC card cannot be modified...; said digital signature is a function of said service request; A system for request service of a service provider comprising: a user terminal ...; a storage medium...; wherein when the user objects to a charge, in response to a charge collection notice from an accounting terminal, the user enables a sending of data said storage medium to said accounting terminal, and the accounting terminal determines whether said service request and said digital signature are valid before collecting a fee from the user terminal.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spies, U.S. Patent No. 6, 055, 314, in view of Pitroda, U.S. Patent No. 5,884,271.

Regarding to claim 26, Spies discloses a system for requesting service of a service provider comprising:

a user terminal **for** providing to a service provider a service request requesting desired service and a digital signature created based on said service request to said service provider (column 6, lines 35-55, purchaser's computing unit); and

a storage medium **for** storing said service request and said digital signature (column 7, lines 1-67, the IC card 50 stores two asymmetric key pairs; the IC card computes the hash of the order; the IC card encrypts the order and attached the digital signature to the order; column 8, lines 25-47, the package 56 contains policy and program key, is transmitted to the IC card), and

an accounting terminal determines whether said service request and said digital signature are valid before collecting a fee from the user terminal (column 6, lines 35-55, the merchant computing unit 44).

Spies does not disclose wherein when the user objects to a charge, in response to a charge collection notice from an accounting terminal, the user enables a sending of a data stored in said storage medium to said accounting terminal. However, Pitroda discloses through the user of UET card, a substantial amount to such paperwork can be eliminated and transactions with the service companies can be conducted

simultaneously in real time **to resolve disputes** and can be recorded electronically (column 18, lines 3-15), the UET card may be configured with sufficient memory to store all transactions electronically, so as to eliminate or reduce the need for paper receipts (column 11, lines 4-6), the UET card is capable of sending of a data stored in storage medium to the accounting terminal (column 10, lines 25-33). Moreover, it is well known in the art that when the user objects to a charge, the user often submits the transaction receipt to the accounting terminal. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Spies to adopt the feature taught by Pitroda and the well-known feature above, to enable the user sending of a data stored in said storage medium to said accounting terminal when the user objects to a charge, for the purpose of providing more convenient to the user when requesting a dispute transaction, because the user does not need to keep a paper copy of receipt which may be easily lost.

Regarding to claim 27, Spies discloses further wherein said IC card is connectable to said user terminal, and the user sends said data stored in said IC card by submitting said IC card (column 6, line 35-column 7, line 67, the purchaser 26 inserts the IC card 50 into the purchaser's computing unit, the IC card 50 encrypts the purchaser order and attached the digital signature to the order; the order then sent to the merchant).

In response to the applicant's arguments regarding to claims 26 and 27, examiner submits that the arguments are not persuasive. The applicant has not submitted any rebuttal to the well-known statements; the applicant has not presented arguments that

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the features are not well known. This does not constitute a proper challenge to the well-known statements.

Allowable Subject Matter

9. Claims 17, 18 and 20-25 contain allowable subject matter over the prior arts cited of records.

Conclusion

10. Claims 17, 18, and 20-27 are rejected.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

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Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/
Primary Examiner, Art Unit 3692

May 23, 2008